REMARKS

The Office Action rejects claims 1-9 and 11-16 under 35 U.S.C. § 103(a) as being unpatentable over MORRIS et al. (U.S. Patent No. 7,216,144, hereinafter "MORRIS") in view of SLUTSMAN et al. (U.S. Patent No. 7,177,905, hereinafter "SLUTSMAN"), and TATHAM et al. (U.S. Patent No. 6,223,177, hereinafter "TATHAM") and further in view of LUZESKI et al. (U.S. Patent No. 6,430,177, hereainfter "LUZESKI"). Applicants respectfully traverse and request reconsideration and withdrawal of the outstanding rejections.

Initially, Applicants note that the claims recite (using claim 1 as a non-limiting example):

> An electronic chat joining method in which a chairman who opens an electronic conference sets an area on a database for storing chat messages, and in which guests who join said electronic chat send requests for access to said area to the database from video game terminals of the guests, the method comprising:
>
> storing setup information for setting said area in a storage section of a chairman's video game terminal,
>
> creating from the chairman's video game terminal an invitation message comprising said setup information stored in said storage section,
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> giving an instruction from the chairman's video game terminal for transmission of said invitation message,
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> transmitting from the chairman's video game terminal an invitation signal comprising said setup information to said guests' video game terminals based on only said instruction,
>
> receiving at the guests' video game terminals said invitation signal and obtaining said setup information,
>
> creating at the guests' video game terminals access request signals comprising said setup information, and
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> transmitting from the guests' video game terminals to said database, said access request signals solely in response to each guest's instruction,
>
> the database area storing chat messages that are sent to and from the video game terminals,
>
> wherein the setup information is not visible on the guests' video game terminals; and

wherein the setup information includes a password, which is communicated from the chairman's video game terminal to a server and/or the guests' video game terminals without modification.

The present invention relates to a method and apparatus for joining an electronic conference from a video game machine by using a simple procedure. According to an non-limiting embodiment of the invention, a player (chairman) who decides to open an electronic chat, creates a message (S201, FIG. 2) and sends the message to a Message Server 113, requesting that a chat be opened (S202, FIG. 2). In response, the Message Server 113 sends a setup signal to a Database in a group of servers to open a chat room (S203, FIG. 2), and returns a chat opening signal to the chairman (S204, FIG. 2). Having received the chat opening signal (S204, FIG. 2), the chairman may then send an enter room signal to the Database to gain access to the chat room set up in the Database (S205, FIG. 2). Then, an invitation to chat message, which is based on the earlier created message 201, is displayed on the chairman's terminal (S206, FIG. 2). An invitation signal is then transmitted to a plurality of guests based on the invitation to chat message (S207, FIG. 2). See, e.g., page 9, line 17 through page 10, lines 21 of the present specification.

One of the advantages of the present invention is a reduction in cumbersome procedures required to set up a chat by, for example, formatting the invitation signal (S207, FIG. 2) as shown in FIG. 5. That is, the chairman's terminal automatically sets a user name 501 and a user ID 502 based on information previously registered with the Message Server 113. The chairman's terminal further automatically obtains a chat name 512 and a chat password 513 from the original chat opening message (S201, FIG. 2) and a chat ID 514 from the contents of the chat opening response signal (S204, FIG. 2). This

information (S207, FIG. 2) is then sent to all of the users named in the chat message 201. The chat ID 514 and chat password 513 are not displayed on the terminals of the other users, but are automatically included in a response signal from the other users that wish to join the chat.

In contrast, MORRIS discloses a system for facilitating negotiations between users over a communications network. In this regard, MORRIS discloses a communication protocol, referred to as a "Rendezvous" protocol, which allows users to make proposals and counterproposals concerning particular activities, such as, for example, an online "chat" session, an online computer game, an online purchase, etc. The protocol allows a user who receives an offer to, e.g., chat on a particular subject, to accept, modify and/or reject the terms of the offer. The protocol further allows a user to transmit messages, referred to as "Evil" messages, registering displeasure with any proposal, counterproposal, or acceptance. An Evil message has a cumulative (and potentially exponential) effect upon a recipient's ability to access the computer system's resources. The Examiner asserts that MORRIS discloses an electronic chat system. However, the Examiner concedes that MORRIS fails to teach any of the other elements of the claimed invention.

Thus, the Examiner relies upon SLUTSMAN to teach the following aspects of the invention with regard to independent claims 1, 5 and 9: (1) storing setup information, (2) creating from the chairman's terminal an invitation message, (3) receiving invitation signals at the guests' terminals and obtaining setup information, (4) creating request signals at the guests' terminals, and (5) transmitting the access request signals from the guests' terminals to the database. However, the Examiner concedes that even if

MORRIS and SLUTSMAN were to be combined, the combination of the two disclosures would be deficient in that the combination does not teach that "the setup information includes a password," as recited in the claims. The Examiner, therefore, relies on TATHAM et al. to teach that the setup information includes a password, which is communicated from the chairman's terminal to a server on the guest's video game terminals without modification (TATHAM et al., col. 5, lines 9-15 and col. 5, line 58, to col. 6, line 7).

However, the Examiner still acknowledges that even the combination of MORRIS, SLUTSMAN, and TATHAM is still deficient in that it does not teach that the setup information is not visible on the guest's video game terminal. Therefore, the Examiner relies upon a fourth publication, LUZESKI, to teach this feature (LUZESKI, col. 7, lines 40-43).

This admitted need to rely upon four references clearly indicates that the Examiner has used Applicants' claims as a map or blue print for selecting isolated features from this prior art, rather than logical reasoning. Furthermore, upon review of TATHAM, Applicants submit that TATHAM merely teaches that the "details of the web-site may be sent in the form an e-mail message…with the address of the dedicated site, an invitation to join the workgroup, and, if applicable, a password required for gaining access to the site" (TATHAM et al., col. 5, lines 9-15). However, the setup information of the claimed invention is recited to "set an area on a database in a storage section of a chairman's video game terminal" and the claimed password is used for initiating and authenticating this process. In contrast, TATHAM merely discloses a password, and does not teach setup information, as described in the claimed invention. Accordingly, the

password in TATHAM does not function in the same manner as the claimed password. For at least this reason, Applicants submit that the cited publications (alone or in combination) do not teach all of the elements of the claimed invention, and respectfully request withdrawal of the rejections.

As for LUZESKI, this document discloses a system that allows access to voice, fax, or e-mail message services via a web browser interface (LUZESKI, col. 7, lines 30-33). LUZESKI also teaches that "[e]very subsequent request from the Web browser interface is automatically accompanied by the user's mail profile identifier, password and session ID, although the user is not made aware of this" (LUZESKI, col. 7, lines 40-43). The claims explicitly recite that "the setup information is not visible on the guests' video game terminals." However, the information provided in LUZESKI does not appear to "set… an area on a database in a storage section of a chairman's video game terminal," as recited in the claims. Rather, the Examiner seems to rely upon this document to merely disclose transmittal of information that is not visible to a user. However, LUZESKI does not teach setup information that is "not visible on the guests' video game terminals," as explicitly recited. Thus, Applicants submit that the cited publications fail to disclose or render obvious yet another element of the claimed invention.

Lastly, even in view of recent clarification of standards for combining prior art by the Supreme Court (e.g., *KSR International v. Teleflex*), Applicant submits that there is no logical reason to combine the cited publications. As explained in Section 2142 of the MPEP, "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, …[127 S. Ct. 1727 (2007)], 82 USPQ2d 1385,

1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' " *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Examiner does not provide proper reasons why the claimed invention would be obvious. Rather, the Examiner merely concludes it would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of MORRIS, SLUTSMAN, TATHAM, and LUZESKI because combination of these documents would "enhance the conference negotiating in Morris's systems," "increase the security of Morris's and Slutsman's system," and "increase the efficiency of Morris's, Slutsman's and Tatham's systems" (*see* pages 4 and 5 of the outstanding Office Action). Applicant submits that the Examiner is relying upon impermissible hindsight by relying upon the disclosed advantages of the claimed invention, as provided in the Applicant's own specification, as a roadmap for combining the cited publications. Moreover, the Examiner's conclusions are mere speculation on his part. The Examiner has cited no evidence that the proposed combination will result in the asserted advantages.

Furthermore, upon review of the exemplary rationales provided in MPEP § 2143, it appears that the Examiner has not relied upon any of these exemplary rationales. Although this list is not an exhaustive list of rationales used to support a prima facie case of obviousness, this list simply accentuates that, in the present case, the Examiner has not provided a "clear articulation of the reason(s) why the claimed invention would have been obvious," as recommended by section 2141 of the MPEP and the Supreme Court's

decision in *KSR International*. On the contrary, the Examiner merely focuses upon the advantages of the claimed invention in seeking guidance on why one skilled in the art would combine the cited publications, which the Examiner admits do not teach or even suggest all of the elements of the claimed invention. Applicant submits that this is the very definition of impermissible hindsight.

Even assuming *arguendo* that the Examiner's obviousness conclusion is based upon the assertion that it would have been "obvious to try," Applicant submits that this rationale would be inappropriate because such a rationale is only proper where there is "a finite number of identified, predictable solutions, with a reasonable expectation of success." Applicant submits that there are a myriad of ways in which one could "enhance the conference negotiating in Morris's systems," "increase the security of Morris's and Slutsman's system," and "increase the efficiency of Morris's, Slutsman's and Tatham's systems" (*see* pages 4 and 5 of the outstanding Office Action). Therefore, the Examiner has not set forth a prima facie case of obviousness because the Examiner has not provided a sound rationale for combining the teachings of these publications.

Accordingly, Applicant submits that independent claims 1, 5, and 9 (and claims dependent therefrom) are not rendered obvious by the cited publications, and respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a), together with an indication of the allowability of all claims pending in the present application, in due course. Applicant further submits that dependent claims 2-4, 6-8, and 11-16 are allowable for at least the same reasons applicable to independent claims 1, 5, and 9, and additionally, based upon the specific features recited in each dependent claim.

CONCLUSION

Accordingly, Applicant respectfully requests reconsideration of the outstanding rejections and an indication of the allowability of all of the claims in the present application.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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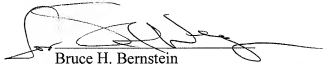

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